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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/820,487	04/07/2004	Jeffrey P. Whitten	532232001200	7396

25225 7590 10/26/2005  
MORRISON & FOERSTER LLP  
12531 HIGH BLUFF DRIVE  
SUITE 100  
SAN DIEGO, CA 92130-2040

EXAMINER

AULAKH, CHARANJIT

ART UNIT	PAPER NUMBER
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1625

DATE MAILED: 10/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/820,487	Applicant(s) WHITTEN ET AL.	
	Examiner Charanjit S. Aulakh	Art Unit 1625	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 September 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-8,10,11,13-22 and 24-42 is/are pending in the application.
- 4a) Of the above claim(s) 28-30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,6,24 and 31-42 is/are rejected.
- 7) ☒ Claim(s) 2-5,7,8,10,11,13-22 and 25-27 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>1 page</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. According to paper filed on Sep. 22, 2005, the applicants have canceled claims 9, 12 and 23 and furthermore, have amended claims 1, 4, 6, 8, 10, 13-22, 26, 31 and 40.
2. Claims 1-8, 10, 11, 13-22, 24-27 and 31-42 are pending in the application. Claims 28-30 remain withdrawn as being directed to non-elected invention.

### ***Response to Arguments***

3. Applicant's arguments filed on Sep. 22, 2005 have been fully considered but they are not persuasive regarding enablement rejection and some indefiniteness rejections. The applicants have amended claims to overcome prior art rejections. In regard to enablement, the examiner does not agree with the applicants arguments that the specification is enabling for treating every known cell proliferative disorder and every known microbial infection. As stated clearly in the last office action, the instant compounds of formula (I) encompasses hundreds of thousands of compounds and therefore, in absence of clear teachings, guidance and presence of working examples, it would require undue experimentation to demonstrate the efficacy of instant compounds in known animal models or cell lines of every known cell proliferative disorder and microbial infection and hence their utility for treating these disorders and infections or titers.

In regard to indefiniteness rejections, the applicants have amended claims to overcome some of these rejections. However, the examiner does not agree with the applicants arguments that the term ---inorganic substituent--- for the value of variable R6 in claims 1 and 24 is definite. The examiner also does not agree with the applicants arguments

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that the terms ---cell proliferative disorder and microbial titers ----- are definite. In regard to claims 35 and 37, the examiner does not agree with the applicants arguments that these claims encompass both in vitro and in vivo methods. The steps for administration of instant compounds are missing for in vivo method and furthermore, for in vitro method, it is not clear what is meant by system? Is it a cell, plasma, blood, specific tissue etc.?

### ***Conclusion***

4. Rejection of claims 31-42 under 35 U.S.C. 112, first paragraph is maintained for the reasons of record.
5. Rejection of claims 1, 24 and 31-42 under 35 U.S.C. 112, second paragraph is maintained for the reasons of record.
6. Rejection under 35 U.S.C. 102(b) is withdrawn in view of amendments.

### **NEW GROUNDS OF REJECTION**

#### ***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1 and 6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, last two lines, the proviso is not needed since W can not be hydroxy or ethoxy according to amended claim.

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In claim 6, line 1, something is missing after C1-10. Is it alkyl?

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

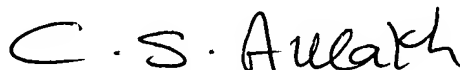
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charanjit S. Aulakh whose telephone number is (571)272-0678. The examiner can normally be reached on Monday through Friday, 8:30 A.M. to 5:00 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cecilia Tsang can be reached on (571)272-0562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Charanjit S. Aulakh  
Primary Examiner  
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